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STAAS & HALSEY LLP			ROBERTSON, DAVID	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/646,890

Applicant(s)

WATANABE ET AL.

Examiner

Dave Robertson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is a Final Office Action in response to the reply received 1/28/2009. Claims 1-15 are pending.

Response to Amendment

2. Applicant amends claims 1 and 13 to recite the method as being *performed by a processor*. However, the steps of the method remain lacking of any tie to another statutory class of invention, such as a particular apparatus. As such the claims remain non-statutory and the rejections previously made over claims 1-9 and 13-15 are maintained.
3. Applicant amends independent claims 1, 10, 11, and 12 to recite steps and means for presenting an input form and accepting form replies from a *second respondent*. Claim 13 is amended to recite closing the input form. These amendments are addressed below.

Response to Arguments

4. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.
5. Applicant does not traverse Examiner's assertion of facts by official notice in the prior office action (see OA of 10/28/2008, page 9, i.e. *surveys may be implemented in Microsoft Excel forms feature...*; and page 10, *computer program data have numerical limits...*). Because Applicant has not specifically pointed out any errors in the

Examiner's taking of Official Notice, the officially noticed facts are deemed admitted prior art. See MPEP § 2114.03 (C).

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-9 and 13-15 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions:

For a process to be patentable subject matter under § 101 the process must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform subject matter to a different state or thing. See *Diamond v. Diehr*, 450 US 175, 184 (1981); *Parker v. Flook*, 437 US 584, 588 n9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 US 780, 787-88 (1876). If neither of these requirements is met by the claim, the method is not a patent eligible process. To qualify under § 101 as a statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

In the present case, the claims fail to recite transforming subject matter to a different state or thing or positively recite a sufficient tie to another statutory class of invention, such as a particular apparatus. Mere recitation of an apparatus or article in the preamble of a claim does not transform an unpatentable process into a patentable process. For example, claim 1 recites in the preamble *A method...performed by a processor....* However, mere recitation of *a processor* in the preamble does not limit any particular step of the process to being performed by the processor. Further, insignificant extra-solution activity such as data gathering, data output, transmitting or display, does not transform an unpatentable process into a patentable process. For

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example, claim 1 further recites *presenting an input form and accepting input*. However, as such, the method could be performed entirely by a human, by hand, or by mental steps, therefore the invention as claimed is ineligible for patenting and thus nonstatutory subject matter under 35 U.S.C. 101. Claims 2-9 and 13-15 are similarly deficient.

Appropriate amendment is required.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-6 and 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson, Lois ("*each Yourself Microsoft Excel® 97 in 24 Hours*", 1997).

Claim 1

Patterson teaches:

a first questioning by presenting an input form with question to a first respondent (pages 359, 365; MS Excel may be used to create surveys/online forms to present questions to users and receive their responses.);

obtaining a free reply by accepting input onto the input form by a first respondent of an unguided reply to said question (pages 60-61 and 359; Users may input data a variety of ways, including via free form text boxes/cells in which the user may enter any input, thereby constituting an unguided reply.);

a first storing for storing the free reply input by the first respondent as a reply option to said question (pages 307; The forms created in MS Excel are linked to databases to store the responses.);

presenting an input form with said question and the stored free reply to a respondent after storing the free reply by [a] respondent (pages 359, 365; MS Excel may be used to create surveys/online forms to present questions to users and receive their responses, where the forms may be presented to multiple users.);

and presenting to the respondent the reply stored in said first storing (pages 60-61 and 76; MS Excel provides the "autofill," "autocomplete" and "picking from the list" tools, where a previous entry in a cell may be used to fill in a second entry in another cell.).

However, Patterson does not expressly teach **closing the input form presented to the first respondent or presenting the input form to a second respondent** for a second questioning.

Official notice is taken as old and well known that input forms of Microsoft Excel can be closed, saving the status of the users work, and re-opened by a different (second) user. That Microsoft Excel forms provide means for surveying users, it would have been obvious to one of ordinary skill in the art at the time of the invention that such a feature as presenting the survey form to a first user, having the user close the input form (saving the status of form field entries), and then reopening the form (file) by a second user would have predictably resulted in the accumulation of survey data into a single file by two respondents, where the saved *free reply* field entry of the first

respondent would have been readily available as a stored "autocomplete" reply to the second respondent, thereby simplifying data collection by providing in a single file, the stored responses to different users.

Claim 2

Patterson teaches:

obtaining an elective reply by accepting from a second respondent selection of a reply presented in said presenting to the second respondent and a second storing of storing an elective input by the second respondent (page 307; The forms created in MS Excel are linked to databases to store the responses accepted and received from the surveys.);

and compiling by repeating said first questioning, said obtaining the free reply step, said first storing, said second questioning, said presenting, said obtaining an elective reply-step, and said second storing, and collecting and compiling elective replies and free replies from said respondent group (pages 238 and 307-309; For as many input fields there are in the survey/form, there are matching data fields in the database to store each reply to each question, thereby enabling multiple responses to be received and stored from multiple respondents.).

Claims 3 and 14

Patterson teaches **a first determining to determine whether a free reply input by a first respondent and a predetermined reply option presented are substantially the same, wherein said presenting further presenting at least one predetermined reply option** (pages 60-61 and 76; MS Excel provides the "autofill,"

“autocomplete” and “picking from the list” tools, where a previous entry in a cell may be used to fill in a second entry in another cell. The “autofill,” “autocomplete” and “picking from the list” tools use an auto-recognition feature to determine whether the previous entry and the subsequent entry are substantially the same.).

Claim 4

Patterson teaches **wherein said first storing stores said free reply as a reply option to said question, said first determining having determined that said free reply input by said first respondent and said predetermined reply option are not substantially the same** (pages 60-61 and 76; MS Excel provides the “autofill,” “autocomplete” and “picking from the list” tools, where a previous entry in a cell may be used to fill in a second entry in another cell. The “picking from the list” tool provides a list of options from several previous entries when it is determined that there is not a specific data entry pattern.).

Claim 5

Patterson teaches **wherein said first determining having determined that said free reply input by said first respondent is substantially the same as said predetermined reply, said compiling compiles said free reply as an elective reply made by selection of said predetermined reply** (pages 60-61 and 76; MS Excel provides the “autofill,” “autocomplete” and “picking from the list” tools, where a previous entry in a cell may be used to fill in a second entry in another cell. The “autofill,” “autocomplete” and “picking from the list” tools use an auto-recognition feature to determine whether the previous entry and the subsequent entry are substantially the

same. If they are the same and the user allows the auto-fill to occur, then the entry is submitted and accepted as the user's input.).

Claims 6 and 15

Patterson teaches **confirming, upon said first determination determining having determined that said free reply input by said first respondent and said predetermined reply option are substantially the same, accepting from said first respondent confirmation as to whether the determination is correct, wherein said compiling is carried out if said determination is confirmed to be correct** (internally, for Autofill and Autocomplete to work properly as explained above in claims 3 and 5, each free reply in a cell is checked to avoid reentry of duplicate reply options, thereby *confirming* that a free reply input is substantially different from a predetermined reply and thus enabling the Autofill feature.).

Claims 10-13 recite apparatus and computer program product claims with substantially functionally equivalent limitations to claims 1-63 already rejected above, and are rejected on the same basis for the respective claim and claim elements.

10. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson, Lois, *Teach Yourself Microsoft Excel® 97 in 24 Hours*, 1997 as applied to claims 1, 2, 4, 5 and 6 above.

Claim 7

Patterson does not expressly teach *conditions setting by accepting settings on conditions for designating at least one or more first respondents, wherein in said*

questioning, said question is presented to one or more first respondents who have been extracted based on said conditions.

Official notice is taken that surveys, such as the ones which may be implemented in Microsoft Excel forms, are presented to respondents according to conditions designating desirable respondents from a population of potential respondents.

It would have been obvious to one of ordinary skill in the art at the time of the invention to set such conditions and extract respondents in the use of Microsoft Excel to conduct surveys as it is impractical to survey all possible respondents and extracting those meeting conditions leads to selection of populations of respondents whose responses are of some value to the survey.

Claim 8

Patterson does not expressly teach determining of increasing a count of reply options and determining that said reply options count has reached said maximum value, and "re-surveying" upon such determination.

Official notice is taken that computer programs have numerical limits as to how much data they can store in a data structure such as a list and that such fixed limits are a "predetermined maximum".

While Patterson does not expressly teach the limits of the AutoFill feature of Microsoft Excel, were limits not employed it would result in users entering free replies beyond the limits of the program thus crashing the program and rendering it inoperable. Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to employ such limits, thereby keeping an increasing count of reply options

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and determining the count has reached a maximum value, to avoid such program failures, and in such limit conditions, “re-survey” or prompt the user for a different input thereby to ensure that the user’s needs are best met given the limits of the computer program.

11. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patterson, Lois, *Teach Yourself Microsoft Excel® 97 in 24 Hours*, 1997 [hereinafter, Patterson] and Walker et al. (U.S. 6,616,458).

Claim 9

Patterson does not expressly disclose a polling method according to either claim 1 or claim 2, further comprising: an iterating step of repeating said first question step, said free reply step and said first storage step; and a control step in which said iterating step is terminated, and said presentation step and said second question step are performed.

Walker et al. discloses an iterating step of repeating said first question step, said free reply step and said first storage step and a control step in which said iterating step is terminated, and said presentation step and said second question step are performed (col. 6, lines 7-25; col. 11, lines 23-32; col. 12, lines 4-18; A surveying methodology is disclosed in which questions are asked and replies to the questions are received until a certain criteria is met or there are no more questions, in which the questions are no longer asked. Additionally, a second question may not be asked until a response to a first question is received.).

Patterson and Walker et al. are analogous in that both discuss ways of creating surveys, including asking questions and receiving responses to the questions. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Patterson to include the surveying features of Walker et al. as such features allow a survey administrator to control who the respondents are as well as the order in which questions are asked, thereby enhancing the data integrity of the survey responses (Walker et al., col. 3, lines 29-43).

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Robertson whose telephone number is (571)272-8220. The examiner can normally be reached on 8 am to 6 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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